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| 09/543,381 | 04/05/2000 | Michael C. Chen | KTI-001 | 7208 |

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BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER

VANDERPUYE, KENNETH N

ART UNIT PAPER NUMBER

2661

DATE MAILED: 07/31/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,381

Applicant(s)

CHEN ET AL.

Examiner

Kenneth N Vanderpuye

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28,29 and 42-46 is/are allowed.
- 6) ☒ Claim(s) 1,2,9-16,23-26 and 30-41 is/are rejected.
- 7) ☒ Claim(s) 3-8 and 17-21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-4. 6) ☐ Other:

DETAILED ACTION

Claim Objections

Claim 30 is objected to because of the following informalities:

In claim 30 line 6, "a first" should be changed to --the first--

In claim 30 lines 9, "a second" should be changed to --the second--

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 30, it is not clear which network (first or second) stated earlier in the claim represents the circuit switched network.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (6,490,274).

Claims 25-26 are rejected because Kim teaches a method comprising the steps of:

Receiving a code (telephone number of called party, Fig. 1@114) by a first station (Fig. 1@106) at a network server (Directory server), the code uniquely identifying a second station (telephone number identifies 114); identifying a data network address of the first station based at least in part upon the code (Directory server uses telephone number to search for the

destination IP address); and causing a communication channel between the first and second stations to be established for voice communications through the data network, using the data network address of said first station (col. 1 lines 52-67, col. 2 lines 1-6).

Claim 27 is rejected because implicit in the accessing of the directory server is a search request because the directory server acts on the telephone number by searching for the IP address corresponding to the telephone number.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 9-16, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaziri et al (6,377,570).

With regards to claim 1 Vaziri teaches a method comprising: receiving a data network address (each party gets the other parties telephone number, however the IP addresses are exchanged after disconnection Fig. 5@516) for a first station by a second station via a first

communication channel routing over a first network(Fig. 5, PSTN), the data network address uniquely identifying the first station; disconnecting from the first communication channel, the first station and the second station(Fig. 5@508, 510); and causing a second communication channel for voice communication over the second network between the first station and the second station(Fig. 5@518, IT channel), using the data network address received at the second station.(Fig. 5@516). As stated earlier the network addresses are exchanged after the disconnection of the call over the PSTN however they are needed to setup the second channel over the internet. The decision to exchange IP addresses before or after disconnecting is obvious as a matter of design choice.

Claim 2 is rejected because Vaziri teaches a gateway (Fig. 9, ISP) for connecting between the PSTN and Internet).

With regards to claims 9-11, the use of an activation means for sending the IP address is obvious as a matter of design choice. The examples stated in these claims are one of several ways of sending an address to a recipient. As stated earlier the network addresses are exchanged after the disconnection of the call over the PSTN however they are needed to setup the second channel over the internet. The decision to

exchange IP addresses before or after disconnecting is obvious as a matter of design choice.

Claim 12 is rejected in light of the reasons for rejecting claim 1. Each step in Fig. 5 is automatic.

Claims 13-15 are rejected because the stations are telephonic devices, the second network is an internet.

Claim 16 is rejected for the same reasons as claim 1.

With regards to claims 22-24, the use of an activation means for sending the IP address is obvious as a matter of design choice. The examples stated in these claims are one of several ways of sending an address to a recipient. As stated earlier the network addresses are exchanged after the disconnection of the call over the PSTN however they are needed to setup the second channel over the internet. The decision to exchange IP addresses before or after disconnecting is obvious as a matter of design choice.

Allowable Subject Matter

Claims 28-29, 42-46 allowed.

Claims 3-8, 17-21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth N Vanderpuye whose telephone number is 703-308-7828. The examiner can normally be reached on M-F(7:30-5:00) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on 703-305-4703. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/543,381
Art Unit: 2661

Page 8



KENNETH VANDERPUYE
PRIMARY EXAMINER

Ken Vanderpuye
July 26, 2003